

REMARKS

This application has been reviewed in light of the Office Action dated August 28, 2009. Claim 1-8 and 10 are presented for examination, of which 1, 8 and 10 are in independent form. Claim 9 has been canceled without prejudice or disclaimer of subject matter, and will not be mentioned further. Claims 1-8 and 10 have been amended to define still more clearly what Applicant regards as his invention. The specification and abstract have also been amended, and Replacement Sheets of drawings have been submitted. Favorable reconsideration is respectfully requested.

In the outstanding Office Action, the drawings were objected to for various informalities. Applicant has amended the specification to mention reference character S709, which appears in Fig. 7B, in para. [0051]. Applicant has also amended Figs. 2, 3 and 5 to eliminate those reference characters that are not mentioned in the specification. It is believed that the above-mentioned drawing objections have been obviated and their withdrawal is, therefore, respectfully requested.

The abstract was objected to for being too long. Applicant has amended the Abstract to be under 150 words. In addition, Applicant notes that Applicant has no intent to incorporate the material in Japanese Patent Application Publication 08-163288 into the present application; the mention of that Japanese document in para. [0003] is merely a reference. It is believed that the above-mentioned objections have been obviated and their withdrawal is, therefore, respectfully requested.

Claims 1-8 and 10 were objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention. Without conceding the validity of these objections, Applicant has carefully reviewed

and amended the claims in an effort to ensure that proper antecedence is maintained, and that the claims are clear. It is believed that the above-mentioned objections have been obviated and their withdrawal is, therefore, respectfully requested.

Claims 1, 2, 4-8 and 10 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 5,570,205 (Sugita et al.) in view of Japanese Patent Application Publication 07-283894 (Kawasaki), and Claim 3, as being unpatentable over *Sugita* in view of *Kawasaki* and of U.S. Patent 3,688,032 (Dixon et al.).

Applicant submits that the independent claims, together with their dependent claims, are patentable over the cited prior art for at least the following reasons.

As discussed in the specification, a facsimile (fax) machine could be used to receive a fax, where an image is received from another fax machine and *recorded* on a blank sheet of paper (para. [0001]). It could also be used to send a fax, where an original sheet of paper (with an image) is *read* and the resulting image is transmitted to another fax machine. Conventionally, the recording path where the blank sheet of paper is conveyed and the reading path where the original sheet is conveyed are separate (para. [0002]). Even if the recording path and the reading path could be merged into one paper conveying path, there is the challenge of coordinating all fax-receiving and fax-sending activities to achieve high throughput and efficiency (para. [0005]).

According to various aspects of the present invention, if a fax-sending request is received during the processing of a fax-receiving request, instead of waiting for the processing of the fax-receiving request to be completed before starting the processing of the fax-sending request, Applicant has found a more efficient approach, as follows.

The reading of the original sheet and storage of the resulting image is performed using the paper conveying path while the reception and storage of the image sent from another fax machine is also performed (para. [0046]-[0048]). When the reading of the original sheet and the reception of the incoming fax image are complete, the recording of the incoming fax image is performed using the paper conveying path while the sending of the outgoing fax image is also performed (para. [0049]-[0053]). Specifically, the use of the paper conveying path switches automatically from the reading of the original sheet to the recording of the incoming fax image (para. [0037]). In this way, the paper conveying path is efficiently utilized while the processing of the fax-sending request could complete earlier.¹

Claim 1 recites, among other features, a control means that controls the image communication apparatus in such a way that in a case where a transmitting instruction means instructs the reading of the original sheet and transmitting the second image data while a first communication means receives first image data and a first accumulating means accumulates the first image data, the conveying mechanism automatically switches from conveying the original sheet to conveying the recording sheet after the reading means completes the reading of the original sheet and the first communication means completes the reception of the first image data.

This control means is not believed to be disclosed or suggested in *Sugita* or *Kawasaki*, considered separately or in any permissible combination.

As Applicant understands, *Sugita* relates to a fax apparatus which includes a paper conveying path (sheet carrier path) adapted to both convey an original sheet to be read, and a blank sheet of paper on which an image is to be recorded (*see* Abstract). The fax apparatus also includes a selecting device, such as a switch, that a user operates to indicate whether the fax

¹ It is to be understood that the scope of the claims is not limited by the details of this or any other embodiment that may be referred to.

machine should function in a transmitting mode, where an original sheet of paper is scanned and then transmitted to another fax machine, or in a receiving mode, where incoming fax image is received from another fax machine and recorded on a blank sheet of paper.

Specifically, the user's operation of the selecting device directs the use of the paper conveying path. Only upon the indication of entering the transmitting mode, would the paper conveying path be used for conveying an original sheet of paper (*see* col. 4, lines 32-36), and only upon the indication of entering the receiving mode, would the paper conveying path be used for recording an image on a blank sheet of paper (*see* col. 5, lines 31-35). Therefore, *Sugita* is not believed to disclose or suggest that "said conveying mechanism automatically switches from conveying the original sheet to conveying the recording sheet after said reading means completes the reading of the original sheet and said first communication means completes the reception of the first image data", as recited in Claim 1.

Even if *Kawasaki* discloses every feature for which it is cited, that would not supply the teaching that Applicant has argued above is missing from *Sugita*. Accordingly, Claim 1 is believed patentable over *Sugita* and *Kawasaki*, considered separately or in any permissible combination.

Independent Claims 8 and 10 recite features similar to those discussed above with respect to Claim 1 and, therefore, are also believed to be patentable over *Sugita* and *Kawasaki* for the reasons discussed above.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims. Therefore, the independent claims are believed to be allowable over the art of record.

The other claims in this application are each dependent from Claim 1, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Leonard P Diana/
Leonard P. Diana
Attorney for Applicant
Registration No.: 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
New York, New York 10104-3800
Facsimile: (212) 218-2200